



DT20 Rec'd PCT/PTO 23 JAN 2003

#11 PCT

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PATENT  
Attorney Docket No. 229752001400

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

*In re* patent application of:

S. Kent et al.

Group Art Unit: to be assigned

Serial No.: 09/831,307

Examiner: to be assigned

Filed: May 8, 2001

**BOX PCT**

Title: A VIPOX VECTOR CODING AN HIV ANTIGEN AND A CYTOKINE

**ATTN: PCT LEGAL OFFICE**

Assistant Commissioner for Patents  
United States Patent and Trademark Office  
Washington, D.C. 20231

Dear Sir:

**RESPONSE TO NOTIFICATION REGARDING DEFECTIVE DECLARATION**

In response to the Notification Regarding Defective Declaration, mail dated January 14, 2003, applicant respectfully provides the following materials and information.

In the Notification received from Richard Cole, legal examiner, and Derek Putonen, attorney advisor, both of the PCT Legal Office, applicant is advised that the declaration submitted on January 7, 2002, with regard to this application is defective because it names three inventors whereas the international application names only two, Stephen Kent and Ian Allister. The third person named on the allegedly defective declaration, David B. Boyle, is listed on the international application, not as an applicant/inventor, but only as an applicant and thus, his signature of the declaration renders the declaration defective.

The Notification also indicates that a proper response to the Notification may be made by showing that a change was made under PCT Rule 92bis indicating that Mr.

Boyle was an applicant/inventor and not just an applicant, provided that the change was requested prior to the National Stage filing date of May 9, 2001.

Accordingly, enclosed herewith is a copy of applicant's request under PCT Rule 92bis, that Mr. Boyle be changed from applicant to applicant/inventor. As indicated therein, the request was properly and timely filed with the Commissioner on Patents of the Australian Patent Office, acting as the International Receiving Office, on January 13, 2000, nearly 16 months prior to the national stage filing date.

In addition, and to further confirm that the request was properly submitted prior to the National Phase filing date, also enclosed is a copy of the Notification of the Recording of a Change received from the International Bureau of WIPO, indicated that the change was properly and timely requested and there after recorded. That Notification of Recording of a Change should have been transmitted to all national stage patent offices, in this case, the U.S. Patent and Trademark Office.

Thus, as the change of Mr. Boyle from applicant to applicant/inventor was properly and timely made by applicant, no further response to the Notification is required and the declaration previously submitted is not defective.

**Conclusion**

Although no fees are believed to be due with the filing of this response, if there are any fees that are later determined to be due, please charge any and all such fees to Deposit Account No. 03-1931.

Respectfully submitted,  
MORRISON & FOERSTER, LLP

Date: January 23, 2003

By: 

James Remenick  
Registration No. 36,902

For: Barry E. Bretschneider  
Registration No. 28,055

Enclosed: Request for Change under PCT Rule 92bis  
Notification of the Recording of a Change

MORRISON & FOERSTER, LLP  
1650 Tyson's Blvd; Suite 300  
McLean, Virginia 22102  
Tel: (703) 760-7700  
Fax: (703) 760-7777

12 January, 2000

The Commissioner of Patents  
WODEN ACT 2606

*Acting as the International Receiving Office*

Our Ref: 2231646/TDO/AG

Re: Commonwealth Scientific and Industrial Research Organisation  
AND The Australian National University AND The Macfarlane  
Burnet Centre for Medical Research  
International Patent Application No. PCT/AU99/00989  
"Avipox vector coding an HIV antigen and a Cytokine"

Sir,

In partial response to the Invitation to Correct Defects dated 15 December 1999, we enclose herewith the following:

1. Formal Figures.
2. Power of Attorney (x 2)

Upon reviewing the PCT Request Form, it has come to our attention that an inadvertent error occurred in relation to detailing the Applicant details pertaining to David Bernard Boyle. We respectfully request that under the provisions of Rule 92bis of the PCT Regulations, the details in relation to Dr. Boyle be amended to correctly read as follows:

III-4-1	This person is:	<i>Applicant and Inventor</i>
III-4-2	Applicant for:	<i>US only</i>

Dr. Boyle is currently designated as Applicant only for all designated states except the United States. This is incorrect and we respectfully request the International Receiving Office to resolve this matter by amending Dr. Boyle's details.

Yours respectfully,  
DAVIES COLLISON CAVE

E JOHN L HUGHES

Davies Collison Cave  
PATENT & TRADE MARK  
ATTORNEYS

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DaviesCollison Cave Solicitors  
Intellectual Property Law

PCT

NOTIFICATION OF THE RECORDING  
OF A CHANGE

(PCT Rule 92bis.1 and  
Administrative Instructions, Section 422)

From the INTERNATIONAL BUREAU OF

To:

SLATTERY, John, M.  
Davies Collison Cave  
1 Little Collins Street  
Melbourne, VIC 3000  
AUSTRALIE

Date of mailing (day/month/year)

23 May 2001 (23.05.01)

Applicant's or agent's file reference

2231646--TDO

IMPORTANT NOTIFICATION

International application No.

PCT/AU99/00989

International filing date (day/month/year)

09 November 1999 (09.11.99)

1. The following indications appeared on record concerning:



the applicant



the inventor



the agent



the common representative

Name and Address

BOYLE, David, Bernard  
6 Mary Place  
Leopold, VIC 3224  
Australia

(Applicant only for all designated States except  
US)

State of Nationality

AU

State of Residence

AU

Telephone No.

Facsimile No.

Teleprinter No.

2. The International Bureau hereby notifies the applicant that the following change has been recorded concerning:



the person



the name



the address



the nationality



the residence

Name and Address

BOYLE, David, Bernard  
6 Mary Place  
Leopold, VIC 3224  
Australia

(Applicant/Inventor for US only)

State of Nationality

AU

State of Residence

AU

Telephone No.

Facsimile No.

Teleprinter No.

3. Further observations, if necessary:

4. A copy of this notification has been sent to:



the receiving Office



the International Searching Authority



the International Preliminary Examining Authority



the designated Offices concerned



the elected Offices concerned



other:

The International Bureau of WIPO  
34, chemin des Colombettes  
1211 Geneva 20, Switzerland

Facsimile No.: (41-22) 740.14.35

Authorized officer

M. ABIDINE (Fax 338.87.40)

Telephone No.: (41-22) 338.83.38

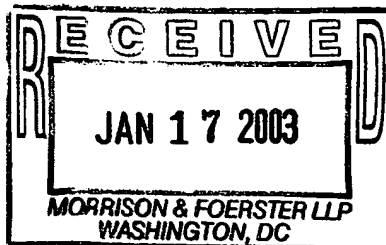
14 JAN 2003



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

Barry E. Bretschneider  
Morrison & Foerster, LLP  
2000 Pennsylvania Avenue, N.W.  
Washington, D.C. 20006-1888



In re Application of  
KENT, et al.  
Application No.: 09/831,307 ✓  
PCT No.: PCT/AU99/00989  
Int. Filing Date: 09 November 1999  
Priority Date: 09 November 1998  
Attorney Docket No.: 229752001400  
For: A VIPOX VECTOR CODING AN HIV  
ANTIGEN AND A CYTOKINE

NOTIFICATION REGARDING  
DEFECTIVE DECLARATION

AND

REQUIREMENT FOR NEW  
DECLARATION OR REQUEST  
UNDER 37 CFR 1.497(d)

This is to notify applicants that the declaration filed on 07 January 2002 in the above-captioned application is not in compliance with 37 CFR 1.497(a) and that a new declaration or submission under 37 CFR 1.497(d) is required.

### BACKGROUND

On 09 November 1999, applicants filed the above-captioned international application, which claimed a priority date of 09 November 1998 and designated the United States. The international application named Stephen Kent and Ian Allister Ramshaw as applicants/inventors and David Bernard Boyle as an applicant only. A Demand for international preliminary examination was filed prior to 19 months from the priority date. Accordingly, the thirty-month period for paying the basic national fee expired at midnight on 09 November 2001.

On 08 May 2001, applicants filed a transmittal letter for entry into the national stage in the United States which was accompanied by, *inter alia*, a basic national fee of \$860 and a PCT International Search Report.

On 15 June 2001, applicant was mailed a "Notification of Missing Requirements" (Form PCT/DO/EO/905) requiring an oath or declaration in compliance with 37 CFR 1.492(a) and (b) and the surcharge 37 CFR 1.492(e). The notification set a two-month time limit in which to respond.

On 14 September 2001, applicants filed a declaration naming as inventors and signed by: Stephen Kent, Ian Allister Ramshaw and David Bernard Boyle. The response was accompanied by a petition for a one-month extension of time and thus timely filed.

DOCKETED ACE KSF  
Correction of  
Inventorship due 2-14-03

On 06 December 2001, applicant was mailed a "Notification of Defective Response" (Form PCT/DO/EO/916) requiring an executed oath or declaration in compliance with 37 CFR 1.492(a) and (b), payment of the appropriate surcharge under 37 CFR 1.492(e), as well as, the filing of a sequence listing for the present application.

On 07 January 2002, applicant filed a declaration naming as inventors and signed by: Stephen Kent, Ian Allister Ramshaw and David Bernard Boyle and a sequence listing.

### **DISCUSSION**

The declaration filed 07 January 2002 is not acceptable. Specifically, the declaration sets forth an additional inventor (David Bernard Boyle) who has not been named in the international application. Mr. Boyle was listed as an applicant only in the published international application. As such, the filed declaration is a defective response to the "Notification of Defective Response" mailed 06 December 2001 indicating that the declaration was not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68. However, since the "Notification of Defective Response" did not indicate the fact that the declaration was also defective since an additional inventor appeared on the declaration, applicant is hereby afforded **ONE (1) MONTH** to file one of the following responses:

Applicant must submit either: 1) a submission under 37 CFR 1.497(d) requesting correction of the inventors named in the international application to include David Bernard Boyle, (2) a new declaration naming and signed by only by Stephen Kent and Ian Allister Ramshaw accompanied by an acceptable explanation of the misnaming of the inventor on the present declaration, or (3) a showing that a change under PCT Rule 92bis was made prior to the National stage filing.

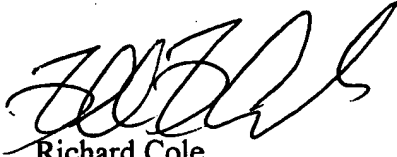
A submission under 37 CFR 1.497(d) to correct an error in naming inventorship requires:

- (1) a petition including a statement from each person being added or deleted as an inventor that the error in inventorship occurred without any deceptive intention on his or her part;
- (2) an oath or declaration by the actual inventor(s) as required by 37 CFR 1.63;
- (3) the fee set forth in 37 CFR 1.17(i); and
- (4) if an assignment has been executed by any of the original named inventors, the written consent of the assignee in compliance with 37 CFR 3.73(b).

### **CONCLUSION**

A proper response, as discussed above, must be filed within **ONE (1) MONTH** of the date of mailing of this notification. No extensions of this time limit may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of the letter marked to the attention of the PCT Legal Office.



Richard Cole  
Legal Examiner  
PCT Legal Office



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